

REMARKS

The outstanding final Office Action mailed July 12, 2004 (Paper No. 21) has been carefully considered. Claims 27-54 are now pending in the present application. Claims 27 and 31 have been amended. It is believed that the amendments to the claims do not add new matter. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

Response to 35 U.S.C. §102 Rejection

I. Response to Rejections of Claims 27, 28, 31, 53, and 54

Claims 27-32 and 53 and 54 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Welsh (U.S. Patent No. 4,829,5589).

A. Applicants' Response to the Rejection of Claim 27

With regard to claim 27, Applicants have amended claim 27 to include the limitation of "displaying the video signal and the screen of first operation data." Applicants respectfully submit that the cited art of record apparently fails to disclose the claimed limitation. Therefore, Applicants respectfully request that this rejection be withdrawn.

Furthermore, Applicants respectfully submit that the amendment to claim 27 should be entered because it does not raise new issues that would require the U.S.P.T.O. to conduct another search. Claim 46, which was added in Applicants' First Response, received by the U.S.P.T.O. on February 23, 2004, includes the limitation "outputting the screen such that the screen is displayable on a television, wherein **the screen appears superimposed upon the image created by the video signal.**" (Emphasis Added.) Applicants respectfully submit that the issues raised by the amendment to claim 27 are substantially similar to the issues of claim 46, and therefore, no new search is required.

B. Applicants' Response to the Rejection of Claim 28

With regard to claim 28, Applicants have claimed "the subscriber terminal retrieves the associated screens from the system manager and stores the associated

screens in the subscriber terminal memory prior to their actual use.” The Office Action states “the screens are sent from the system manager (central computer 25).” (See page 5, 2nd paragraph.) Applicants believe that *Welsh* apparently fails to disclose that the “subscriber terminal **retrieves** the associated screens from the system manager.” (Emphasis added.) Therefore, Applicants respectfully request that this rejection be withdrawn.

C. Applicants’ Response to the Rejection of Claim 31

With regard to claim 31, Applicants have amended claim 31 to include the limitation of “the terminal displays a feature start screen and the video signal.” Applicants respectfully submit that the cited art of record apparently fails to disclose the claimed limitation. Therefore, Applicants respectfully request that this rejection be withdrawn.

Furthermore, Applicants respectfully submit that the amendment to claim 31 should be entered because it does not raise new issues that would require the U.S.P.T.O. to conduct another search. Claim 46, which was added in Applicants’ First Response, received by the U.S.P.T.O. on February 23, 2004, includes the limitation “outputting the screen such that the screen is displayable on a television, wherein **the screen appears superimposed upon the image created by the video signal.**” (Emphasis Added.) Applicants respectfully submit that the issues raised by the amendment to claim 31 are substantially similar to the issues of claim 46, and therefore, no new search is required.

D. Applicants’ Response to the Rejection of Claim 53

With regard to claim 53, claim 53 is as follows:

A method of providing services to guests of a subscriber of an interactive entertainment system, the method comprising the steps of:
providing a plurality of two-way terminals;
generating at the premises of a subscriber a screen for display on a television, wherein **the screen relates to information about services provided by the subscriber** of the interactive entertainment system; and
receiving a selection from a guest. (Emphasis Added.)

Statement of Rejection:

Referring to claim 53, Welsh discloses providing a plurality of two-way terminals (see Figure 1 for homes 9, which all contain terminal 13).

Welsh also discloses generating at the premises of a subscriber a screen for display on a television, wherein the screen relates to information about services provided by the subscriber of the interactive entertainment system (see Column 4, Lines 53-56 for generating (at an FM station) and displaying (on a television) screens and Column 4, Lines 42-46 for the system providing home shopping services), and wherein the services for selection are offered by an interactive entertainment system (see FM broadcast station 5 in Figure 1, which provides the screen data to the terminals at Column 4, Lines 53-56). The examiner notes that since the FM broadcast station 5 in Figure 1 is sending the interactive screens (users can respond to the screens) to the users in their homes, the FM broadcast station 5 is therefore, an interactive entertainment system.

Applicants' Response:

Claim 53 includes the limitation that **“the screen relates to information about services provided by the subscriber.”** Applicants respectfully submit that the cited reference fails to disclose a subscriber that provides services. Applicants respectfully submit that *Welsh* apparently fails to disclose services offered by a subscriber of an interactive entertainment system, and consequently, the cited reference fails to disclose **a screen that relates to information about services provided by the subscriber** of the interactive entertainment system. Therefore, Applicants respectfully request that this rejection be withdrawn.

E. Applicants' Response to the Rejection of Claim 54

With regard to claim 54, claim 54 is as follows:

A system for providing services to guests of a subscriber of an interactive entertainment system, the system comprising:

means for receiving content provided by the interactive entertainment system;

means for distributing the received content to terminals located at the premises of the subscriber;

means for generating screens of information related to services provided by the subscriber of the interactive entertainment system;

and

means for receiving a request for a service by a guest. (Emphasis Added.)

Statement of Rejection:

Referring to claim 54, see rejection of claim 53 and note that Welsh discloses receiving (television programs) as well as screens (see Column 8, lines 20-24).

Applicants' Response:

Claim 54 includes the limitation “means for **generating screens** of information **related to services provided by the subscriber** of the interactive entertainment system.” Applicants respectfully submit that the cited reference fails to disclose a subscriber that provides services, and consequently, the cited reference fails to disclose the limitation of “generating screens ... related to services provided by the subscriber.” Therefore, Applicants respectfully request that this rejection be withdrawn.

Response to 35 U.S.C. §103 Rejections

I. Response to Rejections of Claims 33, 37, 39, 40, 43, and 46

Claims 33, 37, 39, 40, 43, and 46 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Welsh (U.S. Pat. No. 4,829,558) in view of Kirschner et al. (U.S. Pat. No. 4,253,157). Applicants traverse the rejections for at least the following reasons.

A. Applicants' Response to the Rejection of Claim 33

Regarding claim 33, Applicants have claimed “**generating** at the premises of a subscriber a screen of **a menu for selecting services**, wherein the screen is one of a plurality of screens included in the menu, and **wherein the services for selection are offered by** at least one of the group consisting of **an interactive entertainment system and a subscriber of the interactive entertainment system.**” Applicants respectfully submit that the cited art of record fails to disclose a menu for selecting services offered by a subscriber of an interactive entertainment system because the cited references

apparently fail to disclose a subscriber of the interactive entertainment system who offers services. Therefore, Applicants respectfully request that this rejection be withdrawn.

B. Applicants' Response to the Rejection of Claim 37

With regarding to claim 37, Applicants have claimed "the screen is a check out screen that enables the guests to check out from the premises of the subscriber using the terminal." The Office Action states:

The Examiner takes Official Notice that it is well-known to allow a guest to check out of a hotel room using his/her terminal. It would have been obvious to a person of ordinary skill in the art to modify the screens provided by Welsh and Kirschner to include a check out screen for the purposes of allowing a guest to avoid long lines at the check out desk upon departure of his/her stay at a subscriber premises.

Applicants traverses the rejection for at least the following reasons:

- 1) Applicants believe that the Office Action's failure to recite features supported in documentary evidence is in itself evidence that none was available, thus it is not well-known to one of ordinary skill in the art. Accordingly, for this reason alone, the allegation is improper and the rejection should be withdrawn
- 2) Applicants believe that the rejections run counter to stated U.S.P.T.O. rules of examination, and consequently, the rejection is improper. Specifically, the MPEP section 2144.04(E) states "as noted by the court in *Ahlert*, any facts so noticed should be of **notorious** character and serve **only to "fill in the gaps" in an insubstantial manner** which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection." (Emphasis Added.) Applicants respectfully submit that at the time the invention was made it was not "notorious" for guests to use a check out screen. Furthermore, Applicants respectfully submit Official Notice is proper "only to fill in the gaps in an insubstantial manner." Here, the Official Notice is not being used to fill in the gaps in an insubstantial manner. Therefore, for at least the reasons given hereinabove Applicants request that this rejection be withdrawn.

C. Applicants' Response to the Rejection of Claim 40

With regard to claim 40, Applicants have claimed "associating a given screen of the menu with a given television channel." The Office Action states:

Welsh discloses associating a given screen of the menu with a given television channel (see Column 10, lines 23-38 and note that Kirschner is used to teach a menu screen).

Welsh also discloses outputting the given screen from the terminal such that the screen is displayable on a television tuned to the given television channel (see Column 10, lines 62-64).

However, column 10, lines 23-38 of *Welsh* disclose:

At a later time the response can be remotely read by the central computer 25. The microprocessor 43 at a given time on the clock 60 dials the central computer as described before. The microprocessor 43 then reads the stored responses from the RAM 51 and sends them to the UART 44 to the central computer 25.

Applicants respectfully submit that the cited portions of *Welsh* apparently fails to disclose associating a **given television channel** with a given screen. Therefore, Applicants respectfully request that this rejection be withdrawn.

D. Applicants' Response to the Rejection of Claim 43

With regard to claim 43, claim 43 is as follows:

43. The method of claim 40, wherein the screen is for providing information about services offered by the subscriber.

Statement of Rejection:

Referring to Claim 43, see rejection of claim 33 where both *Welsh* and *Kirschner* disclose offering services by the subscriber.

Applicants Response:

The Office Action states in the rejection of claim 33 that "the Examiner notes since the FM broadcast station 5 in FIG. 1 is sending the interactive screens (users can respond to screens) to the users in [their] homes, the FM broadcast station 5 is therefore an interactive entertainment system." Therefore, Applicants assume that the Office

Action is equating Applicants' "subscriber" with the "viewer" of *Welsh* because the Office Action has failed to cite a portion of *Kirschner* that discloses an interactive entertainment system.

Assuming arguendo that the FM station of *Welsh* is an interactive entertainment system and that *Welsh's* "viewer" corresponds to Applicants' "subscriber," Applicants respectfully submit that *Welsh's* viewer apparently fails to offer services. Consequently, if *Welsh* fails to disclose services offered by the viewer, then Applicants respectfully submit that *Welsh* and *Kirschner* fail to disclose a "screen for providing information about services offered by the subscriber." Therefore, Applicants respectfully request that this rejection be withdrawn.

E. Applicants' Response to the Rejection of Claim 46

With regard to claim 46, the Office Action states:

The examiner takes Official Notice that it is well-known to overlay text data over a video signal. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify *Welsh* and *Kirschner*, using a overlay device for the purpose of allowing a viewer to view both the television program and the screen data at the same time so that a user can still enjoy his/her program while viewing additional data.
(Emphasis Added.)

Applicants traverses the rejection for at least the following reasons:

- 1) Applicants believe that the Office Action's failure to recite features supported in documentary evidence is in itself evidence that none was available, thus it is not well-known to one of ordinary skill in the art. Accordingly, for this reason alone, the allegation is improper and the rejection should be withdrawn
- 2) Applicants believe that the rejections run counter to stated U.S.P.T.O. rules of examination, and consequently, the rejection is improper. Specifically, the MPEP section 2144.04(E) states "as noted by the court in *Ahlert*, any facts so noticed should be of **notorious** character and serve **only to "fill in the gaps" in an insubstantial manner** which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection." (Emphasis Added.) Applicants respectfully submit that at the time the invention was made it was not "notorious" to

superimpose a screen upon an image. Furthermore, Applicants respectfully submit Official Notice is proper "only to fill in the gaps in an insubstantial manner." Here, the Official Notice is not being used to fill in the gaps in an insubstantial manner. Instead, the Official Notice is being applied to negate an entire clause in the claim, and Applicants respectfully submit that such use of Official Notice cannot be considered as filling in the gaps in an insubstantial manner. Therefore, for at least the reasons given hereinabove Applicants request that this rejection be withdrawn.

Prior References Made of Record

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 27-32 and Previously Presented claims 33-52 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


Jeffrey R. Kuester, Reg. No. 34,367

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500